



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/382,834 08/25/99 BEAMAN

B Y0993-028BX

EXAMINER

MMC2/1005

DANIEL E MORRIS
INTELLECTUAL PROPERTY LAW DEPT
IBM CORPORATION
P O BOX 218
YORKTOWN HEIGHTS NY 10598

NGUYEN, V

ART UNIT

PAPER NUMBER

2858

DATE MAILED:

10/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/382,834

Applicant(s)

BEAMAN ET AL.

Examiner

VINH P NGUYEN

Art Unit

2858

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-60 are is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.
2. Claims 29,35 and 53-60 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

It appears that the original specification does not have support for the limitations of "the flexible contact elements deflect away from the original shape when said flexible contacts contact the electronic components; the flexible contact elements substantially return to the original shape when the flexible contact elements are withdrawn from contacting the electronic component" as recited in claims 29 and 53-60.

3. Claims 42-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 42, it is unclear what "socket" represents. Is it shown in any of drawings? In claim 45, it is unclear how a probe card "is interrelated and associated with the first substrate". In claim 49, it is unclear what "means, within each of the first substrate" and "plurality of first substrates" represent. Are they shown in any of drawings? In claim 51, "said second substrates" has not been recited previously, therefore this term is indefinite. In claim 52, it is unclear what "

a plurality of said second substrates” represent. Are they shown in any of drawings? “said second substrates” has not been recited previously, therefore this term is indefinite.

The dependent claims not specifically address share the same indefiniteness as they depend from rejected base claims.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 30-51 (insofar as understood) are rejected under 35 U.S.C. 102(b) as being anticipated by Bove et al (Pat # 4,038,599).

As to claims 30-34,35,38,39-41,43-51, Bove et al disclose a high density wafer contacting and test system having a second substrate (20) with a plurality of flexible contact elements (19) for making contact with the dies or integrated circuits formed on the wafer (“16” as Packaging substrate), a first substrate or transformer (13) with a first plurality of conductive lands (13a) for electrically connecting to the second substrate (20) and an electrical testing apparatus (14,15) electrically connected to the first and second substrate through a plurality of electrical connections (11,13). It appears that the probe elements (19) are flexible. As to claim 36, it appears that the end of each probe (19) has a protuberance. As to claim 37, it appears that the

probes (19) are shaped wires disposed on the surface of the second substrate. As to claim 42, it appears that the second substrate is aligned to the first substrate by a socket (17a). As to claims 45 and 47-48, it appears that the probes (19) are free standing flexible conductors.

6. Applicant's arguments filed on 09/30/2001 have been fully considered but they are not persuasive.

In Applicants' remarks, it appears that Applicants improperly found the supports for those issues above not in the instant application, therefore Applicants failed to provide supports in the instant application for questioned issues under 35 USC 112, 2nd paragraph such as "socket" in claim 42, "means within said first of the first substrate" and "a plurality of first substrates" in claim 49, "said second substrates" in claim 51 and "a plurality of said second substrates" in claim 52.


Furthermore, it appears that the probes of Bove et al are flexible conductors since everything has a degree of flexibility. Therefore Bove et al meet the limitations of the instant claims.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE**

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VINH P. NGUYEN whose telephone number is (703) 305-4914. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4900.


VINH P. NGUYEN
PRIMARY EXAMINER
ART UNIT 2858
10/04/2001